

***IN THE UNITED STATES PATENT AND TRADEMARK OFFICE***

Applicant: James W. Taylor et al.

Title: STABILIZED WATER-BORNE  
POLYMER COMPOSITIONS  
FOR USE AS WATER-BASED  
COATINGS

Appl. No.: 10/711,481

Filing Date: 9/21/2004

Patent No.: 7470751

Grant Date: 12/30/2008

Examiner: Tae H. Yoon

Art Unit: 1796

Confirmation 5480

Number:

**PETITION TO THE DIRECTOR UNDER 37 C.F.R. §§ 1.181, 1.182, or 1.183**  
**REGARDING THE DENIAL OF A REQUEST FOR RECONSIDERATION OF PATENT**  
**TERM ADJUSTMENT UNDER 37 C.F.R. §1.705(d)**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Applicants respectfully petition the Director to reconsider the DISMISSAL of a REQUEST RECONSIDERATION OF THE PATENT TERM ADJUSTMENT (PTA) determined for the captioned patent, which issued on 12/30/2008 as U.S. Patent No. 7,470,751. The Dismissal was made in a communication as mailed from the PTO on March 30, 2009.

The Patent Office determined that the patent was entitled to 679 days of PTA. Applicants believe that this PTA determination was made in accordance with the "Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C.

§154(b)(2)(A)" published at 69 Fed. Reg. 34238 (Jun. 21, 2004). Under that interpretation of the PTA statute, any PTO delay under 35 U.S.C. § 154(b)(1)(A) is deemed to overlap with any 3-year maximum pendency delay under 35 U.S.C. § 154(b)(1)(B), and so, as a practical effect, PTA may be awarded under §154(b)(1)(A) or §154(b)(1)(B), but not both.

On September 30, 2008, the United States District Court for the District of Columbia issued a decision finding that the U.S. Patent and Trademark Office's interpretation of the PTA statute is incorrect. *Wyeth v. Dudas*, Civ. Action No. 07-1492 (JR) (Sep. 30, 2008). The court determined that, under the correct interpretation of the PTA statute, periods of "overlap" are limited to "periods of time...[that] occur on the same day." *Wyeth*, slip op. at 8. Thus, a PTO delay under §154(b)(1)(A) overlaps with a delay under §154(b)(1)(B) only if the delays "occur on the same day." *Id.*

Applicants recalculated PTA for the captioned patent under the court's interpretation of the PTA statute, and determined that the patent is entitled to 995 days PTA, as shown on the attached sheet, which shows the relevant delays under 37 CFR §§1.702(a) and (b), and under 37 CFR §§1.703(a) and (b).

There were no circumstances during the prosecution of the application resulting in the patent that constitute a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in § 1.704.

(a) Total of non-overlapping PTO delay under §154(b)(1)(A) & (B): 995 days

(b) Total Applicant delay: 0 days

Final PTA Determination: 995 days

Applicants therefore respectfully requested that the patent be accorded 995 days PTA.

This request was Dismissed by the PTO on March 30, 2009, and Applicants now petition the Director to reconsider their request for reconsideration of PTA, and because an appeal in the *Wyeth v. Dudas* matter is currently pending at the U.S. Court of Appeals for the Federal Circuit, under Federal Circuit Docket No. 2009-1120, the Applicants RESPECTFULLY REQUEST THAT A DECISION ON THIS PETITION BE DEFERRED OR DELAYED until a final decision has been rendered in *Wyeth v. Dudas*.

Payment of the requisite fee under 37 C.F.R. § 1.17(f) is submitted herewith. However, because this petition was only necessary due to PTA error, due to a Patent Office error in interpreting and applying the PTA statute, a refund of the fee is respectfully requested.

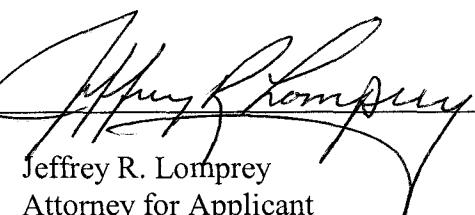
Applicants again request further that a decision on this petition be deferred or delayed until a final decision has been rendered in *Wyeth v. Dudas*, which is now on appeal at the U.S. Court of Appeals for the Federal Circuit, under Federal Circuit Docket No. 2009-1120.

Respectfully submitted,

Date 5/29/09

FOLEY & LARDNER LLP  
Customer Number: 23524  
Telephone: (608) 258-4288  
Facsimile: (608) 258-4258

By



Jeffrey R. Lomprey  
Attorney for Applicant  
Registration No. 55,401

CLOSE WINDOW

All Cases SELECT CASE

## Patent Term Adjustment Calculation System

Add a new event to this case

Docket Number: 018894-0178  
 Application Number: 10/711481  
 Patent Number: N/A

	Event Description	Event Date	Days from Filing	PTO Days	Applicant Days
Edit Delete	Application Filing Date	09/21/2004	0		
	14 month From Application date	11/21/2005	426		
	3 Year Period Starts	09/21/2007	1,095		
Edit Delete	Restriction Requirement	10/01/2007	1,105		
Edit Delete	Restriction Requirement Response Received at PTO	11/01/2007	1,136		
Edit Delete	Non-Final Office Action	12/26/2007	1,191		
Edit Delete	Non-Final Office Action Rsp. Rcv'd at PTO	03/19/2008	1,275		
Edit Delete	Final Office Action	05/16/2008	1,333		
Edit Delete	Request For Continued Examination	08/12/2008	1,421		
	3 Year Period Stopped	08/12/2008	1,421	(326) 995	
Edit Delete	Notice of Allowance	09/05/2008	1,445		
Edit Delete	Issue Fee Paid	11/25/2008	1,526		
Edit Delete	Patent Grant Date	12/30/2008	1,561		
				Totals: 995	995
				PTA: 0	
					995

669 days from 14 month  
 Start of 3yr. to grant  
 To grant

326 from  
 Start of  
 3yr. to grant -  
 followed by  
 filing of RCE on  
 8/12/08

$$\begin{array}{r} 669 \\ + 326 \\ \hline 995 \end{array}$$
  
 995 days to  
 grant

Created and maintained by  
**FOLEY**  
 FOLEY & LARDNER LLP

Version: 3.02.01

LOGIN: Sharon Dudley

IP: 10.24.4.200

Foley &amp; Lardner LLP